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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/404,715	09/24/1999	TOSHIHISA KUMAKURA	511.37656X00	8711

20457 7590 05/29/2002

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 05/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T.D-8

Office Action Summary

Application No.

09/404,715

Applicant(s)

KUMAKURA ET AL

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3,7-11,20 and 21 is/are allowed.
- 6) ☒ Claim(s) 4-6, 12-14 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

- 1) ***Claims 15-18 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7, 03/25/02.***

Specification

- 2) ***The disclosure is objected to because of the following informalities: On at least pages 3, 13 and 14, "polyfunctional (meth)acrylate compounds" are defined as a species of "thermosetting resins".***

Appropriate correction is required.

Claim Rejections - 35 USC § 112

- 3) ***The following is a quotation of the second paragraph of 35 U.S.C. 112:***
- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.***
- 4) ***Claims 4-6, 12-14 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.***
- A) ***The recited "wherein said composition comprises thermosetting resins" per claims 4 and 5 constitutes indefinite subject matter as per it not being readily ascertainable as to how said "thermosetting resins" further limit the antecedently recited "thermosetting resin".***
- B) ***The recited "at least one of an antioxidant, a metal scavenger or a lubricant" per claim 13 should correctly read "at least one of an antioxidant, a metal scavenger and a lubricant".***

C) *The recited "wherein each of th at least one of a----" per claim 19 engenders superfluous subject matter.*

Allowable Subject Matter

5) *Claims 1, 3, 7-11, 20 and 21 are deemed allowable over the prior art of record, including Satoh et al(U.S.6,165,617), as per one having ordinary skill in the art would not have been endowed with any motivation to extrapolate the meticulously defined polyvinyl acetal/thermosetting resin/polyfunctional (meth)acrylate compound combination-governed adhesive composition for a metal foil from any of the prior art of record with any reasonable expectation of success. Claims 4-6, 12-14 and 19 would be allowable if rewritten and/or amended so as to obviate the 112, 2nd paragraph issues raised supra.*

Response to Arguments

6) *Applicant's arguments filed 03/25/02 have been fully considered and found persuasive with the understanding that the arguments relative to Sato et al actually apply to Satoh et al, such considered to be an obvious typographical error. See page 18, paragraph 1 of Counsel's response. Clarification on the record is requested.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703) 308-4346. The examiner can normally be reached on Monday-Friday, 6:30 A.M.-3:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wu David can be reached on (703) 308-2450. The fax phone numbers for the organization wh re this application or proceeding is assign d are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2381.

JMR *JMR*
May 28, 2002

Judy M. Reddick
JUDY M. REDDICK
PRIMARY EXAMINER
GROUP 1700